

Application N. 10/039,555
Amdt. Dated May 20, 2004
Reply to Office Action of May 11, 2004

REMARKS/ARGUMENTS

1. Remarks on the Amendments

Claims 13, 19 and 22 have been amended to more specifically define Applicants' claimed invention. Antecedent basis of the amendments and the new claims can be found on page 9, third paragraph, and on page 10, third paragraph of the Specification as filed.

Applicants respectfully submit that no new matter has been added by the amendments of the Specification and claims.

There are a total of 14 claims pending.

2. Response to the Rejections of Claims Based Upon 35 USC §103(a)

Claims 13-26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Tseng (US 5,615,945). This rejection is respectfully traversed by the amendment.

Claims 13, 19 and 22 are independent claims, and Claims 14-18 are dependent claims of Claim 13; Claims 20-21 are dependent claims of Claim 19, and Claims 23-26 are dependent claims of Claim 22, respectively.

A determination under 25 U.S.C. §103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. *In re Mayne*, 104 F.3d 1339, 1341, 41 USPQ 2d 1451, 1453 (Fed. Cir. 1997). An obviousness determination is based on underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and prior art; and (4) the objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966), see also *Robotic*

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Vision Sys., Inc. v. View Eng'g Inc., 189 F.3d 1370 1376, 51 USPQ 2d 1948, 1953 (Fed. Cir. 1999).

In line with this standard, case law provides that "the consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art." *In re Dow Chem.*, 837 F.2d 469, 473, 5 USPQ 2d 1529, 1531 (Fed. Cir. 1988). The first requirement is that a showing of a suggestion, teaching or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." *In re Dembiczak*, 175, F.3d 994, 1000, 50 USPQ 2d 1614, 1617.

The second requirement is that the ultimate determination of obviousness must be based on a reasonable expectation of success. *In re O'Farrell*, 853 F.2d 894, 903-904, 7 USPQ 2d 1673, 1681 (Fed. Cir. 1988); see also *In re Longi*, 759 F.2d 887, 897, 225 USPQ 645, 651-52 (Fed. Cir. 1985). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992).

The examiner has the burden of establishing a prima facie case of obviousness. *In re Deuel*, 51 F.3d 1552, 1557, 34 USPQ 2d 1210, 1214 (Fed. Cir. 1995). The burden to rebut a rejection of obviousness does not arise until a prima facie case has been established. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ 2d 1955, 1967 (Fed. Cir. 1993). Only if the burden of the establishing prima facie case is met does the burden of coming forward with rebuttal argument or evidence shift to the application. *In re Deuel*, 51 F.3d 1552, 1557, 34 USPQ 2d 1210, 1214

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(Fed. Cir. 1995), see also *Ex parte Obukowicz*, 27 USPQ 2d 1063, 1065 (B.P.A.I. 1992).

Applicant submits that nothing in the art of record teaches or suggests the subject matter positively recited in amended independent Claims 13, 19 and 22. As recited in Claims 13 and 22, the instant device for the illumination of an interior of a computer case is positioned inside the computer case by inserting a base bracket to a space for the expansion slot cover bracket. Further as recited in Claim 19, the instant method includes inserting a base bracket of a lamp means into a void space generated by removing a pre-existing expansion slot cover bracket from a rear wall of a computer, thereby positioning the lamp means inside of the computer case.

On the contrary, Tseng's lighting device is located outside of the computer case, and used outside of the computer case. These fundamental differences are clearly stated by the Examiner in the instant Office Action.

Accordingly, Applicant maintains that the claimed invention is unobvious in view of the prior art of record.

With regard to Claims 14-18, 20-21 and 23-26, as described above, these claims are dependent upon independent Claims 13, 19 and 22, respectively. Under the principles of 35 U.S.C. §112, 4th paragraph, all of the limitations of each independent claim are recited in its respective dependent claims. As described above, independent Claims 13, 19 and 22 are unobvious in view of the prior art of record, as such Claims 14-18, 20-21 and 23-26 are submitted as being allowable over the art of record.

Accordingly, Applicant respectfully requests withdrawal of the rejection of Claims 13-26 based upon 35 U.S.C. §103(a).

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It is respectfully submitted that Claims 13-26, the pending claims, are now in condition for allowance and such action is respectfully requested. Applicant's Agent respectfully requests direct telephone communication from the Examiner with a view toward any further action deemed necessary to place the application in final condition for allowance.

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